



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

m. H.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,947	08/09/2000	Morten Nyborg	1359-00	3879

22469 7590 05/15/2003

SCHNADER HARRISON SEGAL & LEWIS, LLP
1600 MARKET STREET
SUITE 3600
PHILADELPHIA, PA 19103

EXAMINER

NGUYEN, BINH AN DUC

ART UNIT	PAPER NUMBER
----------	--------------

3713

DATE MAILED: 05/15/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/601,947

Applicant(s)

NYBORG, MORTEN

Examiner

Binh-An D. Nguyen

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. The Request for Continued Examination and the Amendment filed in Papers No. 12 and 13, respectively, March 20, 2003 have been received. According to the Amendment, claims 15-32 have been canceled and new claims 33-46 have been added. Currently, claims 33-46 are pending in the application. Acknowledgment has been made.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 40-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 40 is vague and indefinite since it is unclear whether the applicant claims solely on a system or the applicant solely claims on a method. Note, from claimed limitations of claim 40 and dependent claims 41-46, it appears that the applicant intended to claim a system.

Claims 41-46 are vague and indefinite since it is unclear what types of means being provided in each claim.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 33-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Llenas et al. (5,271,626).

Llenas et al. teaches a system and method for announcing key codes (game clues) to TV viewers via the screen of their TV set in establishing contact between selected viewers and an established game program over a telecommunications network (Figs. 5a-7) comprising: a key code generator for generating key code (game clues) to include a plurality of descriptive elements (5:13-27; 7:42-45), the key code being selected randomly among a predetermined number of different key codes (4:34-54); a key code transmitter for transmitting the key code in succession to the TV screens within a plurality of selected time slots located within a plurality of selected time units between a start and an end of a TV transmission which is at least one of a TV program and a TV commercial spot (4:26-66 and 8:24-41); a line connector for connection of viewers to the game program who are selected as a function of a predetermined number of viewers, who by using the key code manage to establish the contact; the selection of the key code is accomplished automatically (3:1-59); the selection of the time slots is accomplished automatically; duration and position of the time slot within the time unit is selected at random; at least one of duration of descriptive elements of the key code on TV screen and position of descriptive elements within the time slot is selected at random; random selection is made automatically; viewer connection is made via one or more selected from the group consisting of a telephone network and a computer network; and the descriptive elements each comprises one or more selected from the group consisting of symbols, numbers, and letters (Fig. 4a). See also, Figures 2a-7 and columns 1-8.

Note that, the applicant's disclosed key codes which "can be made up completely or partially of, e.g., digits in a telephone number, symbols, letters or combination thereof" (applicant's disclosure, page 3, lines 16-17) are equivalent to Llenas et al.'s clues which comprise letters and digits (3:47-59 and Figures 4a).

6. Applicant's arguments filed in Paper No. 13 have been fully considered but they are not persuasive. Applicant's argument regarding Llenas et al. does not teach the limitation of transmitting key code elements in succession to the TV screen within a plurality of selected time slots located within a plurality of selected time units between a start and an end of at least one of a TV program and a TV commercial spot (page 7, lines 11-18) is not well taken. Llenas et al. does teach "the clues 84 are aired during regular programming time" (7:53-54) and "In addition, the air time during which the game is conducted may comprise regular television programming slots" (8:35-37).

Further, applicant's remarks that Llenas only teaches utilizing black spaces for transmitting key codes (page 7, line 19 to page 9 line 7) is not persuasive since Llenas also suggested transmitting key code during a regular program slot (8:35-37).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 703-305-5713. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers

Application/Control Number: 09/601,947

Page 5


Art Unit: 3713

for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

BN

BN


VALENCIA MARTIN-WALLACE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700